

EL



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,102	09/04/2001	Luis Antonio Ruiz	32935RC497723	2486

7590 02/05/2004

Smith, Gambrell & Russell, LLP,
1850 M Street, N.W., Suite 800
Washington, DC 20036

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 02/05/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944102

Applicant(s)

Ruiy

Examiner

D. J. King

Group Art Unit

3729

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on October 20, 2003
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-31 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-31 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

The rejection under 35 USC 112 set forth in the previous office action are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 10 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Largent.

With the method of Largent is performed on a presbyopic eye with 20/20 vision or on an eye which already has an intermediate vision correction power, the central region will be ablated.

Claims 10, 13, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with Dunn. Largent teaches an optical surface including multiple concentric annular zones of various curvatures. Dunn teaches the various zone radii claimed when producing an optical surface to mitigate presbyopia. It would have been obvious to the artisan of ordinary skill to employ the zone boundaries of Dunn in the method of Largent, since there are appropriate for treating presbyopia; and to produce the aspheric curvature with the claimed angular relations, since these are not critical and Largent gives no caution to avoid these values, thus producing method such as claimed.

Claims 5-7 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with Schimmick. Largent teaches a laser system for correcting presbyopia. Schimmick teaches modifying a laser system. It would have been obvious to relate the tissue removal of Largent to the nasal superior point, since this would amount to a mere shifting of the co-ordinate system the computer uses when producing an optical correction centered on the optical axis and would provide no unexpected result, and to mark the zone which is the reference point, since this would facilitate tracking thereof official notice of which is hereby taken, and to

Art Unit: 3739

employ the modification in the flying spot of Shimmick, since Largent provides not particular laser system, or to use an erodable mask, since this is a notorious equivalent to the flying spot system, official notice of which is hereby taken thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of U.S. Patent No. 6,302,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious variation in scope.

Applicant argues that the central region of Largent is ablated. The examiner must disagree. The cited passage of Largent merely requires that the central region have on intermediate curvature, not that the central region be ablated to achieve this. With respect to the double patenting rejection, the MPEP requires that all applicable rejections be applied. Thus as long as there is no proper terminal disclaimer filed with respect to the patent, the double patenting rejection must be maintained.

Applicant's arguments filed October 30, 2003 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.



Shay/DI

January 13, 2004

**DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330**